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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/740,373 | 12/19/2000 | Samuel N. Zellner | 00383 | 4939 |
| 7590 | 01/26/2004 | | | EXAMINER MILLER, BRANDON J |
| Jonathan C. Parks, Esq. Kirkpatrick & Lockhart LLP Henry W. Oliver Bldg. 535 Smithfield Street Pittsburgh, PA 15222-2312 | | | ART UNIT 2683 | PAPER NUMBER // DATE MAILED: 01/26/2004 |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/740,373 | ZELLNER ET AL. |
| | Examiner | Art Unit |
| | Brandon J Miller | 2683 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-12, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart in view of Baker and Moon.

Regarding claim 1 Stewart teaches sending an advertisement to a user operating a wireless communication device (see col. 17, lines 52-55). Stewart teaches receiving first information about the identity of the user and receiving second information about a location of a user (see col. 18, lines 32-37). Stewart teaches searching a database containing one of a plurality of user-specific advertisements and a plurality of location-specific advertisements (see col. 16, lines 29-35). Stewart teaches accessing a database containing a plurality of user-specific preferences and identifying one or more preferences in a database that are associated with the user (see col. 16, lines 21-28). Stewart teaches selecting one of the plurality of user-specific advertisements and the plurality of location specific advertisements based on one or more preferences in a database (see col. 25, lines 46-52 and col. 26, lines 42-46). Stewart teaches sending one of a plurality of user-specific advertisements to a wireless communication device in

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the form of a message over a communication network (see col. 16, lines 30-35). Stewart teaches sending one of a plurality of location-specific advertisements to a wireless communication device in the form of a message over a communication network without transmitting an indication of the identity of the user (see col. 17, lines 51-56 & 59-60). Stewart does not specifically teach sending an advertisement in the form of a TCP/IP (Transmission Control/Internet Protocol) message or sending a message without transmitting an indication of the location of the user. Baker teaches sending one of a plurality of user-specific and location-specific advertisements to a wireless communication device in the form of a TCP/IP message over a communication network (see col. 6, lines 42-46 & 62-67 and col. 7, lines 12-20). Moon teaches selecting user specific advertisements in a manner that would alleviate privacy concerns by incorporating anonymous association of users to audience information (see col. 4, lines 14-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include sending an advertisement in the form of a TCP/IP (Transmission Control/Internet Protocol) message or sending a message without transmitting an indication of the location of the user because this would allow for secure WEB based distribution of advertisements to wireless communication subscribers.

Regarding claim 3 Stewart, Baker, and Moon teach a device as recited in claim 1 except for receiving the second information about the location of the user that includes obtaining the second information for a fee. Stewart does teach receiving information about the location of a user (see col. 21, lines 50-52). Stewart does teach charging a fee for a provided service (see col. 29, lines 21-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include receiving the second information about

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the location of the user that includes obtaining the second information for a fee because this would allow for subscriber information used in WEB based distribution of advertisements to be available at a charge.

Regarding claim 4 Stewart, Baker, and Moon teach a device as recited in claim 1 except for receiving the first information about the identity of the user that includes obtaining the first information for a fee. Stewart does teach receiving information about the identity of a user (see col. 18, lines 32-34). Stewart does teach charging a fee for a provided service (see col. 29, lines 21-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include receiving the second information about the location of the user that includes obtaining the second information for a fee because this would allow for subscriber information used in WEB based distribution of advertisements to be available at a charge.

Regarding claim 5 Stewart teaches receiving information about the identity of a user that includes obtaining information from a user when the user registers for a service that provides one or more user-specific advertisements to the user (see col. 10, lines 8-18 and col. 12, lines 40-45).

Regarding claim 6 Stewart teaches receiving information about the identity of a user that is accomplished by extracting information from a message transmitted by a wireless communication device (see col. 12, lines 1-8).

Regarding claim 7 Stewart teaches information about the identity of the user that includes information about the location of a user (see col. 18, lines 32-37). Stewart teaches sending one of a plurality of user-specific advertisements to a wireless communication device (see col. 17, lines 52-55). Stewart does not specifically teach sending one of a plurality of user-specific

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advertisements to a wireless communication device without transmitting an indication of the location of the user therewith. Moon teaches selecting user specific advertisements in a manner that would alleviate privacy concerns by incorporating anonymous association of users to audience information (see col. 4, lines 14-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include sending one of a plurality of user-specific advertisements to a wireless communication device without transmitting an indication of the location of the user therewith because this would allow for secure WEB based distribution of advertisements to wireless communication subscribers.

Regarding claim 8 Stewart teaches information about the identity of the user that excludes information about a location of a user (see col. 22, lines 37-41).

Regarding claim 9 Stewart teaches accessing and searching a database, and matching the identity of a user received against each of a plurality of identities stored in a database to determine which of the plurality of user-specific advertisements is associated with a user (see col. 16, lines 30-35).

Regarding claim 10 Stewart teaches a communications network that includes the Internet (see col. 9, lines 35-38).

Regarding claim 11 Stewart teaches receiving information about a location of a user (see col. 21, lines 50-52). Stewart teaches accessing a database containing one of a plurality of location-specific preferences and identifying one or more location-specific preferences in a database that are associated with the location of a user (see col. 27, lines 17-22). Stewart teaches selecting one of a plurality of user-specific advertisements based on location-specific information (see col. 27, lines 6-13). Stewart teaches sending one of a plurality of user-specific

advertisements to a wireless communication device in the form of a message over a communication network (see col. 16, lines 30-35). Stewart does not specifically teach sending an advertisement in the form of a TCP/IP (Transmission Control/Internet Protocol) message or sending a message without transmitting an indication of the location of the user. Baker teaches sending one of a plurality of user-specific and location-specific advertisements to a wireless communication device in the form of a TCP/IP message over a communication network (see col. 6, lines 42-46 & 62-67 and col. 7, lines 12-20). Moon teaches selecting user specific advertisements in a manner that would alleviate privacy concerns by incorporating anonymous association of users to audience information (see col. 4, lines 14-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include sending an advertisement in the form of a TCP/IP (Transmission Control/Internet Protocol) message or sending a message without transmitting an indication of the location of the user because this would allow for secure WEB based distribution of advertisements to wireless communication subscribers.

Regarding claim 12 Stewart, Baker, and Moon teach a device as recited in claim 3 and is rejected given the same reasoning as above.

Regarding claim 18 Stewart and Moon teach a device as recited in claim 13 except for allowing a user to unblock over the Internet the transmission of a second information about the location of a user. Baker does teach a user with the ability to turn off and on location information using a WEB page (see col. 4, lines 26-29 & 44-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include allowing a user to unblock over the Internet the transmission of second information about

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the location of a user because this would allow for direct communication between a WEB based advertisement distributor and a wireless subscriber.

Regarding claim 20 Stewart and Moon teach a device as recited in claim 13 except for one of the plurality of user-specific advertisements that is sent over a communication network in the form of a TCP/IP (Transmission Control Protocol/Internet Protocol) message. Baker teaches sending one of a plurality of user-specific and location-specific advertisements to a wireless communication device in the form of a TCP/IP message over a communication network (see col. 6, lines 42-46 & 62-67 and col. 7, lines 12-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include one of the plurality of user-specific advertisements that is sent over a communication network in the form of a TCP/IP (Transmission Control Protocol/Internet Protocol) message because this would allow for secure WEB based distribution of advertisements to wireless communication subscribers.

Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart in view of Moon.

Regarding claim 13 Stewart teaches sending an advertisement over a communication network to a user operating a wireless communication device (see col. 17, lines 52-55). Stewart teaches receiving first information about the identity of the user and receiving second information about a location of a user (see col. 18, lines 32-37). Stewart teaches searching a database containing one of a plurality of user-specific advertisements and a plurality of location-specific advertisements (see col. 16, lines 29-35). Stewart teaches selecting one of the plurality of user-specific advertisements and the plurality of location specific advertisements based on one

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or more criteria pre-selected by a user (see col. 25, lines 46-52 and col. 26, lines 42-46). Stewart teaches sending one of a plurality of user-specific advertisements to a wireless communication device in the form of a message over a communication network (see col. 16, lines 30-35). Stewart teaches sending one of a plurality of location-specific advertisements to a wireless communication device in the form of a message over a communication network without transmitting an indication of the identity of the user (see col. 17, lines 51-56 & 59-60). Stewart does not specifically teach sending a message without transmitting an indication of the location of the user. Moon teaches selecting user specific advertisements in a manner that would alleviate privacy concerns by incorporating anonymous association of users to audience information (see col. 4, lines 14-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include sending a message without transmitting an indication of the location of the user because this would allow for secure WEB based distribution of advertisements to wireless communication subscribers.

Regarding claim 14 Stewart teaches receiving information about the identity of a user that is accomplished by obtaining the information from an information provider (see col. 21, lines 64-67 and col. 22, lines 5-10).

Regarding claim 15 Stewart and Moon teach a device as recited in claim 14 except for receiving the first information about the identity of the user that includes obtaining the first information for a fee. Stewart does teach receiving information about the identity of a user (see col. 18, lines 32-34). Stewart does teach charging a fee for a provided service (see col. 29, lines 21-23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include receiving the second information about the

location of the user that includes obtaining the second information for a fee because this would allow for subscriber information used in WEB based distribution of advertisements to be available at a charge.

Regarding claim 16 Stewart teaches receiving information about the location of a user that is accomplished by obtaining the information from an information provider (see col. 21, lines 50-55 and col. 22, lines 5-7).

Regarding claim 17 Stewart teaches selecting one of a plurality of user-specific advertisements including, receiving one or more criteria from a user, storing the one or more criteria received from a user in a database, and consulting the one or more criteria while selecting one of the plurality of user-specific advertisements (see col. 25, lines 48-52 & 63-65 and col. 26, lines 42-46).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart in view of Moon and Hidary.

Regarding claim 19 Stewart and Moon teach a device as recited in claim 13 except for disclosing information about the location of a user to an emergency service provider when a user requests emergency help. Hidary does teach providing an emergency channel to an emergency service provider when a user requests emergency help (see col. 2, lines 57-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the invention adapt to include disclosing information about the location of a user to an emergency service provider when a user requests emergency help because this would allow for WEB based distribution of advertisements to bypassed during an emergency situation.

Response to Arguments

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Applicant's arguments with respect to claims 1 and 3-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rouhollahzadeh U.S. Patent 6,208,866 B1 discloses a system and method for location-based marketing to mobile stations within a cellular network.

Findikli U.S. Patent 6,594,482 discloses a controlled transmission of wireless communications device identity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J Miller whose telephone number is 703-305-4222. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

January 13, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600